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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,498	12/09/2003	Adel Farhan Halasa	DN2003-048D01	4622

27280 7590 09/27/2005

THE GOODYEAR TIRE & RUBBER COMPANY  
INTELLECTUAL PROPERTY DEPARTMENT 823  
1144 EAST MARKET STREET  
AKRON, OH 44316-0001

EXAMINER

SHAMEEM, GOLAM M

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/731,498

Applicant(s)

HALASA ET AL.

Examiner

Golam M. M. Shameem, Ph.D.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,4-8 and 11-20 is/are pending in the application.
- 4a) Of the above claim(s) 4-8 and 11-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 02/19/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

This application is a DIV of 10/389,131 03/14/2003, which claims the benefit for domestic priority under 35 U.S.C. § 119(e) [to a provisional application 60/404,081 08/16/2002], is acknowledged.

### ***Status of Claims***

Claims 1, 4-8 and 11-20 are currently pending in the application. Claims 2-3 and 9-10 have been canceled.

Receipt is acknowledged of amendment / response filed on July 25, 2005 and that has been entered.

### ***Information Disclosure Statement***

Receipt is acknowledged of Information Disclosure Statement (IDS), filed on 02/19/2004, which has been entered in the file.

### ***Response to Election/Restriction***

In response to the restriction requirement, Applicants have elected Group I, (which now includes claim 1 drawn to a compound) **without** traverse is acknowledged.

Claims 4-8 and 11-20 are withdrawn from further consideration pursuant to 37 C.F.R. 1.142 (b) as being drawn to a non-elected subject matter. Applicants preserve their right to file a divisional on the non-elected subject matter.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. § 102(b) as being anticipated by Hall *et al* (1996). Applicant claims functionalized monomers for synthesis of rubbery polymers. Hall *et al* also disclose the synthesis of several functionalized rubbery organic compounds at least two of them anticipate the instantly claimed invention of compound (1<sup>st</sup> formula), wherein n is 4 or 5 [STN International, CAPLUS database, RN number, 57236-00-7 and 174572-10-2, a copy is provided with this Office action], which reads on the instantly claimed compounds.

Asratyan *et al* (1975) also disclose the synthesis of several organic compounds at least one of them anticipates the instantly claimed invention of compound (2<sup>nd</sup> formula), wherein sum of n and m is 4 [STN International, CAPLUS database, RN number, 57236-04-1, a copy is provided with this Office action], which reads on the instantly claimed compounds.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claim in the subject matter, which the applicant regards as his invention.

Claim 1 (Currently amended) is rejected under 35 U.S.C. § 112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The recitation of “a structural formula comprised of” (recited in line 2, page 22,) renders the claim indefinite because it is unclear from the claim what the Applicant is intending to encompass with the expression of “a structural formula comprised of”. The word “comprised of” is an open-ended word that, when used with a monomer product

(which is a compound) within a claim, make the claim open-ended and indefinite. The omission of failing to describe the claimed invention renders the claim incomplete. It is suggested to amend the claim with in the context and scope of the claim in order to overcome the rejection.

The meanings of R and R' variables (3<sup>rd</sup> and 4<sup>th</sup> compounds) were deleted from the claim although in chemical structure those variables are still exist. The above expressions are not defined in the claim so as to ascertain the metes and bounds of the claimed subject matter. Appropriate correction is required.

#### ***Remarks***

In claim 1, line 5, compound number “(b)” is left over although other compound numbers were deleted and it is not clear what the Applicant is intending to encompass with this expression “(b)”. Explanation and / or correction are required.

#### ***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Golam Shameem, Ph.D. whose telephone number is (571) 272-0706. The examiner can normally be reached on Monday-Thursday from 7:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached at (571) 272-0699. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone numbers for this Group are 571-273-8300.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) “Official” for papers that are to be entered into the file, and “Unofficial” for draft


documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or public PAIR only. For more information about the pair system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (571) 272-1600.

Golam M M Shameem, Ph.D.  
Primary Examiner  
Art Unit 1626  
Technology Center 1600

A handwritten signature in black ink, appearing to read 'G. M. Shameem', with a stylized, cursive script.

**GOLAM M. M. SHAMEEM, PH.D**  
**PRIMARY EXAMINER**

August 10, 2005